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09/781,605	02/12/2001	Kenneth L. Wright	DATCAR.003A	3816

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KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER

MIZRAHI, DIANE D

ART UNIT PAPER NUMBER

2165

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/781,605

Applicant(s)

WRIGHT ET AL.

Examiner

DIANE D. MIZRAHI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-6 and 9-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 3-6 and 9-17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 02 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5-10-05.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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III. DETAILED ACTION

Claims 1, 3-6, and 9-17 are presented for examination.

Claims 2 and 7 have been canceled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-6, and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teshima (U.S. Patent # 6,272,470) and Zubeldia et al. (U.S. Patent # 6,397,224) in view of Robert L. Clark et al. (US Patent No. 6,149,440 and Clark hereinafter) .

As to Claim 1, Teshima discloses a personal information system, comprising: a subscriber computer with an optical disk

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drive (see column 10, lines 17-21, in case of the optical card, data is input or output by way of a dedicated device driver); a portable optical disk readable by the optical disk drive (see column 10, lines 17-21, optical card, which reads on portable optical disk); a database management server comprising a database (see column 2, lines 15-20, medical information database) and an optical disk writer (see Fig 2, 13 optical input / output unit) wherein the optical disk writer writes the personal data to the portable optical disk (see column 1 lines 17-21 name address blood type etc are stored in the patient card) ... "interacts with the subscriber computer so as to allow viewing of . . . wherein the Internet browser interacts with the database management server so as to allow updating of" (i.e. an image server 2, and two electronic clinical recording systems 3 are interconnected on a local area network (LAN) 4 on the premises. In the other hospital B, an electronic clinical recording system 3 is connected on a local area network (LAN) 4 on the premises. The LANs 4 in hospitals A and B are linked to the Internet 5, whereby both the LANs can communicate with each other) (col 6, lines 49-58) and the claimed limitation of "subscriber" (i.e. inputting login names and passwords, a method of reading operator ID cards, a method of inputting operator's fingerprints, and a method of specifying operator's faces

through taking photographs thereof with cameras etc. (col 16, lines 1-8).

*Regarding Applicant's new claimed limitation of --*

patient record data being organized into a plurality of fields and wherein selected fields of personal data are chosen by the patient from the plurality of fields of personal data --

Teshima and Zubeldia does not teach patient record data being organized into a plurality of fields and wherein selected fields of personal data are chosen by the patient from the plurality of fields of personal data.

Clark teaches patient record data being organized into a plurality of fields and wherein selected fields of personal data are chosen by the patient from the plurality of fields of personal data (col 6, lines 63-67 to col 7, lines 1-56).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima and Zubeldia as modified with Clark to include patient record data being organized into a plurality of fields and wherein selected fields of personal data are chosen by the patient from the plurality of fields of personal data patient record data being organized into a plurality of fields.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the

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teachings of Teshima and Zubeldia as modified to include patient record data being organized into a plurality of fields and wherein selected fields of personal data are chosen by the patient from the plurality of fields of personal data with the teachings of Clark with the motivation to provide for information ... for a patient regarding the risks associated with medical procedures, such information convey to persons relating to the risks associated with certain activities ... in which by nature of the information itself effects a persons legal rights...) (Clark, col 1, lines 31-56).

As to Claim 3, Teshima as modified does not teach wherein the personal data is transferred between the subscriber computer and the database management server in an HIPAA compliant mode.

Zubeldia et al. teaches wherein the personal data is transferred between the subscriber computer and the database management server in an HIPAA compliant mode (see fig 1 and 2, subscriber computer reads on 18, and database server 84, as it creates encoded identity reference from the input to the output data).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima as modified wherein the personal data is

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transferred between the subscriber computer and the database management server in an HIPAA compliant mode.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima as modified with the teachings of Zubeldia et al wherein the personal data is transferred between the subscriber computer and the database management server in an HIPAA compliant mode because the HIPAA establishes severe penalties for "wrongful disclosure" of health information that is individually identifiable. (Zubeldia et al. column 1, lines 57-60).

As to Claim 4, Teshima as modified discloses wherein the transfer of personal data between the subscriber computer and the database management server can be initiated by either the subscriber computer or the database management server (see column 16, lines 37-67 and column 17, lines 1-33, image data can be initiated by the physician for consultation and the image data can also be film digitalized and downloaded to the server where image data reads on personal data) the data transfer occurring either in a real-time mode or a batch mode (see column 5, lines 26-34, the consultation records are stored into the patient card at any time or as a batch job).

As to Claim 5, Teshima as modified discloses wherein the personal data comprises text, image, audio, and video data (see column 9, lines 40-50, in consulting records still image, motion picture, voice, chart, and list can therefore be handled).

As to Claim 6, Teshima discloses method of maintaining personal data on a portable optical disk (see column 10, lines 17-21), the method comprising: writing the personal data onto the portable optical disk wherein the portable optical disk is readable from an optical disk drive (see column 10, lines 17-21) using an Internet web browser interface; and delivering the portable optical disk to a subscriber (delivering the disk can be accomplished by handing the card to a patient or by mail which is well known) "uniformly accessible manner and wherein the personal data residing on the database management server can be updated using an Internet web browser interface" and "optical disk writer..." and "...uniformly accessible manner" (i.e. copy file in patient card) (Figure 9, #151) "... server . . . " (col 16, lines 50-59)... "... updating ... " (i.e. When the patient has come for the first medical care, the "new creation mode" is selected to form an input table of consultation records based on the basic information stored in the patient card. At this time, the name of a medical institution, the year and date of occurrence, and an examining doctor's name are automatically



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registered and displayed) (col 16, lines 12-26) and "optical disk... " (i.e. CD-ROM, floppy disk, portable disk, mini-disk, or magneto-optical disk, files are used according to the DOS format that conforms to the ISO standards and is a de facto standard format and can be constructed as a file system (col 10, lines 11-16).

Zubeldia et al. teaches entering personal data onto a database management server wherein the personal data is stored in the database management server (see fig 2, database server 54, as identifying element of the input data must be entered in the database and column 5, lines 26-34, a name, a birth date, an address, a ZIP code, a telephone number, a healthcare identifier).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima and Zubeldia et al. to include entering personal data onto a database management server wherein the personal data is stored in the database management server.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima with the teachings of Zubeldia et al to include entering personal data onto a database management server wherein the personal data is stored in the database management

server because it allows to identify an individual to whom the patient record pertains to (Zubeldia et al. column 5, lines 26-34).

*Regarding Applicant's new claimed limitation of --*

patient record data being organized into a plurality of fields and wherein selected fields of personal data are chosen by the patient from the plurality of fields of personal data and wherein selected fields of personal data are chosen by the patient from the plurality of fields of personal data --.

Clark teaches patient record data being organized into a plurality of fields and wherein selected fields of personal data are chosen by the patient from the plurality of fields of personal data (col 6, lines 63-67 to col 7, lines 1-56).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima and Zubeldia as modified with Clark patient record data being organized into a plurality of fields and wherein selected fields of personal data are chosen by the patient from the plurality of fields of personal data patient record data being organized into a plurality of fields.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima and Zubeldia as modified patient record

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data being organized into a plurality of fields and wherein selected fields of personal data are chosen by the patient from the plurality of fields of personal data with the teachings of Clark with the motivation to provide for information ... for a patient regarding the risks associated with medical procedures, such information convey to persons relating to the risks associated with certain activities ... in which by nature of the information itself effects a persons legal rights...) (Clark, col 1, lines 31-56).

As to Claim 9, Teshima as modified does not teach wherein entering, writing, and updating the personal data are in an HIPAA compliant mode.

Zubeldia et al. teaches wherein entering, writing, and updating the personal data are in an HIPAA compliant mode (see column 7, lines 17-49, new records are assigned a new code and update records reuse the same code).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima as modified wherein entering, writing, and updating the personal data are in an HIPAA compliant mode.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima as modified with the teachings of Zubeldia

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et al wherein entering, writing, and updating the personal data are in an HIPAA compliant mode because the HIPAA establishes severe penalties for "wrongful disclosure" of health information that is individually identifiable. (Zubeldia et al. column 1, lines 57-60).

As to Claim 10, Teshima as modified discloses using the portable optical disk at any healthcare service center to prevent repetitious registration process at different healthcare service center sites (see Fig. 1, same patient card can be used at Hospital A and B without further registration).

As to Claim 11, Teshima as modified discloses wherein the portable optical disk is created at the health care service center site (see column 3, lines 27-52, an individual keeps a portable storage medium functioned as a clinical recording as a health care/medical care card when consulting at a medical institution implies the card must be created at or with the consent of the health care service center as the card must conform to HTML or SGNIL formats).

As to Claim 12, Teshima discloses a system for maintaining personal data, the system comprising: entering means for entering personal data (see Fig. 6, 120, write consultation records in a patient card); storing means for storing the personal data (see fig. 6, 1116 record name of consulting

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physician); accessing means for accessing the stored personal data (see fig. 6, 116 can select a consultation report from a list) wherein the accessing means comprises a PC with an optical disk drive (see Fig. 1, 11) and an Internet web browser (see column 9, lines 40-53); transferring means for transferring the stored personal data between the entering means and the storing means in a secure mode (see column 8, lines 1-15, operators id is recorded and data encrypting/decrypting makes network safe); and updating means for updating the stored personal data (see column 5, lines 26-34, the updated consultation record is then written in the patient card and stored therein) wherein the updating means comprises using the Internet web browser (see column 9, lines 40-53) and "uniformly accessible manner" (i.e. copy file in patient card) (Figure 9, #151) and the claimed limitation of "that interacts with the storing means so as to allow viewing of the stored personal data" (i.e. activate viewer) (Figure 10).

***Regarding Applicant's new claimed limitation of --***

patient record data being organized into a plurality of fields

--

Teshima and Zubeldia does not teach patient record data being organized into a plurality of fields.

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Clark teaches patient record data being organized into a plurality of fields (col 6, lines 63-67 to col 7, lines 1-56).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima and Zubeldia as modified with Clark to include patient record data being organized into a plurality of fields with the motivation to provide for information ... for a patient regarding the risks associated with medical procedures, such information convey to persons relating to the risks associated with certain activities ... in which by nature of the information itself effects a persons legal rights...) (Clark, col 1, lines 31-56).

Claims 13-17 are rejected under 35 U.S. C. 103(a) as being unpatentable over Teshima (U.S. Patent # 6,272,470) in view of Feinberg (U.S. Patent # 6,415,295).

As to Claim 13, Teshima discloses a portable optical disk (see column 10, lines 17-21, optical card, which reads on portable optical disk) comprising personal data, wherein the personal data comprises demographics (see column 1, lines 17-21, name address), medical data (see column 1, lines 6-8) and conditions of admission (see column 3, lines 16-26, consultation record) in formats including text, images, audio, and video (see

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column 9, lines 40-50, in consulting records still image, motion picture, voice, chart, and list can therefore be handled) wherein the portable optical disk is readable from an optical disk drive (see column 10, lines 1721) using an Internet web browser interface (see column 9, lines 40-53) and "...uniformly accessible manner" (i.e. copy file in patient card) (Figure 9, #151) "... server . . . " (col 16, lines 50-59)... "... updating ... " (i.e. When the patient has come for the first medical care, the "new creation mode" is selected to form an input table of consultation records based on the basic information stored in the patient card. At this time, the name of a medical institution, the year and date of occurrence, and an examining doctor's name are automatically registered and displayed) (col 16, lines 12-26) and "optical disk... " (i.e. CD-ROM, floppy disk, portable disk, mini-disk, or magneto-optical disk, files are used according to the DOS format that conforms to the ISO standards and is a de facto standard format and can be constructed as a file system (col 10, lines 11-16). (See Also, (i.e. an image server 2, and two electronic clinical recording systems 3 are interconnected on a local area network (LAN) 4 on the premises. In the other hospital B, an electronic clinical recording system 3 is connected on a local area network (LAN) 4 on the premises. The LANs 4 in hospitals A and B are linked to

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the Internet 5, whereby both the LANs can communicate with each other) (col 6, lines 49-58) and the claimed limitation of "subscriber" (i.e. inputting login names and passwords, a method of reading operator ID cards, a method of inputting operator's fingerprints, and a method of specifying operator's faces through taking photographs thereof with cameras etc. (col 16, lines 1-8)).

Teshima does not teach wherein the personal data ... living will and power of attorney and generic data ... healthcare.. information... and Internet.

Feinberg teaches wherein the personal data comprises living will and power of attorney (see column 5, lines 39-53, living will reads on donor, power of attorney reads on directives).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima wherein the personal data comprises living will and power of attorney generic data ... healthcare.. information... and Internet (Figures 5 and).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima with the teachings of Feinberg wherein the personal data comprises living will and power of attorney generic data ... healthcare.. information... and Internet with the



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motivation that it allows access to medical information in case of emergency (Feinberg column 1, lines 57-60).

As to Claim 14, Teshima discloses a personal data management system comprising: a portable optical disk (see column 10, lines 17-21, optical card, which reads on portable optical disk) comprising demographics (see column 1, lines 17-21, address), medical data (see column 1, lines 6-8), living will, power of attorney, and conditions of admissions (see column 3, lines 16-26, consultation record) in formats including text, images, audio, and video (see column 9, lines 40-50, in consulting records still image, motion picture, voice, chart, and list can therefore be handled) wherein the portable optical disk is readable from an optical disk drive (see column 10, lines 17-21) using an Internet web browser (see column 9, lines 40-53); and a database management server comprising an optical disk writer and a database wherein the database contains the personal data to be written to the portable optical disk using the optical disk writer (see Fig 1, image database, contains images to be recorded on the card).

Teshima does not teach wherein the personal data comprises living will and power of attorney generic data ... healthcare.. information... and Internet.

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Feinberg teaches wherein the personal data comprises living will and power of attorney (see column 5, lines 39-53, living will reads on donor, power of attorney reads on directives).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima wherein the personal data comprises living will and power of attorney generic data ... healthcare.. information... and Internet (Figures 5 and).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima with the teachings of Feinberg wherein the personal data comprises living will and power of attorney generic data ... healthcare.. information... and Internet with the motivation that it allows access to medical information in case of emergency (Feinberg column 1, lines 57-60).

Regarding Claims 15-17, these limitation noted above, are similar in scope to the rejected claims above and are therefore rejected as set forth above.

**Other Prior Art Made of Record**

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied

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with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

#### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on (571) 272-4083. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-3900 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'Diane Mizrahi', is written over a horizontal line.

Diane Mizrahi  
Primary Patent Examiner  
Technology Center 2100

May 15, 2005